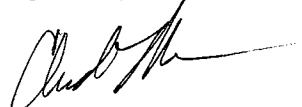


<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b> (filed with the Notice of Appeal)		Docket Number 042933/253085
Application Number 09/977,896	Filed October 15, 2001	
First Named Inventor Cheol-Woong Lee		
Art Unit 2137	Examiner Popham, Jeffrey D.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p style="text-align: right;">Respectfully submitted,  Chad L. Thorson Registration No. 55,675</p> <p>Date <u>May 5, 2008</u></p> <p><b>Customer No. 00826</b> <b>ALSTON &amp; BIRD LLP</b> Bank of America Plaza 101 South Tryon Street, Suite 4000 Charlotte, NC 28280-4000 Tel Charlotte Office (704) 444-1000 Fax Charlotte Office (704) 444-1111</p>		
<div style="border: 1px solid black; padding: 5px;"><p>ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT &amp; TRADEMARK OFFICE ON MAY 5, 2008.</p></div>		

Attachment  
Reasons for Requesting Pre-Appeal Brief Request for Review

Claims 1-3 stand rejected under 35 U.S.C. §103(a), as unpatentable over Fanning (U.S. Patent 6,366,907, hereinafter “Fanning”) in view of Hale (U.S. Patent No. 6,732,180, hereinafter “Hale”) and further in view of Gutberlet (Gutberlet, L., “Peer-to-Peer Computing – A Technology Fad or Fact?”, 10/10/2000, pp. 1-16). Claims 4-6 stand rejected under 35 U.S.C. §103(a), as unpatentable over Fanning in view of Hale and Gutberlet, further in view of Schneier (Schneier, B., “Applied Cryptography”, 1996, pp. 4-5). Claims 7-9 stand rejected under 35 U.S.C. §103(a), as unpatentable over Fanning in view of Hale and Dittmann et al. (Dittmann et al. “Copyright-Copywrong”, 2000, pp 14-17, hereinafter “Dittmann”). Claim 10 stands rejected under 35 U.S.C. §103(a), as unpatentable over Fanning in view of Hale and Gutberlet, further in view of Cuckoo (“How To Lay Cuckoo’s Eggs”, pp. 1-5, 10/18/2000). Claim 11 stands rejected under 35 U.S.C. §103(a), as unpatentable over Fanning in view of Hale and Dittmann, further in view of Cuckoo. Claims 12-18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Fanning in view of Hale and Cuckoo, further in view of various combinations of Dittmann, Gutberlet and Schneier.

Claims 12-18

Independent claim 12 recites, *inter alia*, collecting one of a plurality of digital music files, which are substantially similar to an illegally produced digital music file that has a greatest number of files having the same name, size and playing time. In other words, a single file is selected from among a plurality of files that are substantially similar to an illegally produced digital music file. The single file selected is the one among the plurality of files that has the most files having the same name, size and playing time. Independent claim 12 also recites, *inter alia*, modifying the collected digital music file and redistributing the modified digital music file. According to an embodiment of the present application, illegally produced digital music files may be sought out, collected, modified and redistributed into a network in the modified state.

The Office Action asserts that Fanning discloses collecting one of a plurality of digital music files that has a greatest number of files having the same name, size and playing time (col. 3, line 65- col. 4, line 42 and col. 5, line 46 to col. 6, line 7). However, the cited passages of Fanning fail to teach or suggest this feature. To the contrary, col. 3, line 65- col. 4, line 42 of Fanning describes how a search response is returned to the recipient that displays the results of the search request for the recipient to examine. More specifically, an optimal provider server is selected based on a scoring mechanism including the round trip response time, Internet connection line

speed, size of file and reliability of the service provider. Thus, the only mention of file size in this cited passage of Fanning relates to selecting a server and has nothing to do with collection of a digital music file. Moreover, this cited passage has absolutely no mention of anything remotely related to collecting one of a plurality of digital music files, which are substantially similar to an illegally produced digital music file that has a greatest number of files having the same name, size and playing time. The second cited passage, col. 5, line 46 to col. 6, line 7, relates to the collection of data objects, but again, this cited passage makes no mention of criteria for such collection as including collecting one of a plurality of digital music files, which are substantially similar to an illegally produced digital music file that has a greatest number of files having the same name, size and playing time as recited in independent claim 12. Furthermore, the remainder of Fanning also fails to provide any relevant disclosure in this regard. Accordingly, Fanning fails to teach or suggest collecting one of a plurality of digital music files, which are substantially similar to an illegally produced digital music file that has a greatest number of files having the same name, size and playing time as recited in independent claim 12.

Hale fails to collect any digital music file, but instead merely storing and extracting information about files, and in any case, includes no disclosure related to selecting a file having a greatest number of files having the same name, size and playing time. As such, Applicants respectfully submit that Hale also fails to teach or suggest collecting one of a plurality of digital music files, which are substantially similar to an illegally produced digital music file that has a greatest number of files having the same name, size and playing time as recited in independent claim 12. Moreover, Hale is not cited in connection with this feature.

The Office Action also asserts that Cuckoo discloses the above recited feature at pages 1-3. However, the entirety of the cited passage of Cuckoo fails to provide any teaching or suggestion of collecting one of a plurality of digital music files, which are substantially similar to an illegally produced digital music file that has a greatest number of files having the same name, size and playing time as recited in independent claim 12. In this regard, page 1 of Cuckoo discloses that popular songs may be picked for maximum demand. However, the popular songs are identified immediately thereafter as remixes, duets and live recordings. Nowhere does Cuckoo suggest that “popular” songs are files having the same name, size and playing time. Moreover, Cuckoo never mentions any reference to files having the same name, size or playing time. Accordingly, Cuckoo also fails to teach or suggest collecting one of a plurality of digital music files, which are

substantially similar to an illegally produced digital music file that has a greatest number of files having the same name, size and playing time as recited in independent claim 12.

The Office Action asserts that “the popularity of certain songs is directly proportional to which songs have ‘a greatest number of files having the same name, size and playing time’.” However, there is no support for such a conclusion offered or any citation to any reference disclosing as much. Thus, it is believed that the Examiner is using personal knowledge to fill in the gaps between the claimed invention and the cited references. Applicants note that, as was stated in MPEP 2144.03 regarding *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d at 1697, “the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.” Since no basis can be found for the Examiner’s statements in Cuckoo, Applicants “seasonably challenge” the Examiner’s use of personal knowledge to fill in the gap under MPEP 2144.03.

Notably, although not cited in connection with the rejection of independent claim 12, Gutberlet, Schneier and Dittmann also fail to teach or suggest the above recited feature of independent claim 12. Since none of the cited references teach or suggest, either alone or in combination, collecting one of the plurality of digital music files that has a greatest number of files having the same name, size and playing time as recited in independent claim 12, independent claim 12 is patentable over the combination of Fanning, Cuckoo and Hale. Dependent claims 10 and 11, which depend from independent claims 1 and 7, respectively, also recite the above underlined feature and are patentable over the cited references for the same reasons given above.

In addition, the Office Action continues to refer to Hale as disclosing modifying the collected file and redistributing the modified file. However, Hale discloses the storing and extraction of information about shared media (col. 6, lines 6-8). Specifically, Hale discloses that searches may be performed for proprietary media that falls within a protected class (col. 7, lines 39-40). The search results may be used to generate media templates used in the manufacture of decoy media (col. 7, lines 47-52). The decoy media, which may be shared through a network to dilute the network with decoy media, are constructed based on stored specifications included in the templates (col. 7, lines 61-64 and col. 8, lines 3-5). In other words, the decoy media are created or manufactured based on a template of information related to the proprietary media. The proprietary media is not collected and modified for redistribution. Accordingly, Hale fails to teach or suggest modifying a collected file as recited in independent claim 12. Instead, Hale discloses constructing

the decoy media based on stored specifications having data regarding proprietary media. Indeed, as Hale only discloses the collection of data regarding proprietary media and not the collection of the proprietary media itself, Hale does not have possession of the proprietary media in such a way as to permit its modification. Since Hale never modifies a collected file, but instead creates or constructs a decoy file based on collected data about another file, any file distributed by Hale (i.e., the decoy media) is not a modified digital music file. Thus, Hale fails to teach or suggest modifying the collected digital music file and redistributing the modified digital music file as recited in independent claim 12.

Fanning and Cuckoo also fail to teach or suggest modifying the collected digital music file and redistributing the modified digital music file and are not cited as such. The remaining references also fail in this regard and are not cited as such. Thus, since the cited references fail to teach or suggest, either alone or in combination, modifying the collected digital music file and redistributing the modified digital music file as recited in independent claim 12, any combination of the cited references will likewise fail to render independent claim 12 obvious.

Claims 13-18 depend either directly or indirectly from independent claim 12 and thus include all the recitations of independent claim 12. Therefore, dependent claims 13-18 are patentable for at least those reasons given above for independent claim 12.

#### Claims 1-11

Independent claims 1 and 7 recite, *inter alia*, collecting an illegally produced digital music file, encrypting (claim 1) or inserting a watermark (claim 7) into the collected file and redistributing the encrypted or watermarked file.

It appears from the Office Action that, generally speaking, Fanning is being relied upon for disclosing collecting files, Hale is being relied upon for disclosing modifying and redistributing the modified files, and Gutberlet is being relied upon for disclosing that the modification may include encryption, while Dittmann is relied upon for disclosing that the modification may include watermarking. However, as stated above, Hale is directed to the storing and extraction of information about shared media and the generation of media templates used in the manufacture of decoy media constructed based on stored specifications included in the templates. Accordingly, Hale fails to teach or suggest collecting a file and thus Hale cannot modify a collected file much less redistribute such file. Instead, Hale discloses the collection of data regarding proprietary media and creating the decoy media based on stored proprietary data. Accordingly, the reliance of

the Office Action upon Hale for the concept of modifying a collected file and redistributing such file is misplaced. Hale does not provide for the file that is collected (even assuming Fanning discloses the collection of a file) to be modified by watermarking or encryption and then redistributed. In fact, a combination of the cited references would, at best, appear to suggest the collection of a file, the extraction of various data from the collected file, the creation of a new (i.e., not modified) file, the watermarking or encryption of the new file, and the distribution of the new file. Thus, Hale introduces a completely disjunctive operation of new file creation that does not contemplate the process of the claimed invention nor find the claimed invention within the bounds of its teaching or suggestion. Notably, the Office Action asserts that “to create a degraded version of the proprietary media, the proprietary media must first be obtained.” However, this assertion also completely lacks any support from the disclosure of Hale and is, at best, an inappropriate usage of personal knowledge as described above.

Additionally, neither Gutberlet nor Dittmann cure the deficiencies of the combination of Hale and Fanning, since even if one assumes Gutberlet and Dittmann disclose encrypting and watermarking, respectively, as mechanisms for modifying a file, Gutberlet and Dittmann both fail to teach or suggest any subsequent encryption or watermarking prior to redistribution of a previously collected file. The encryption or watermarking done in Gutberlet and Dittmann is an evolution that is not performed on a file collected via a network and then redistributed via the network after collection and modification. Thus, Gutberlet and Dittmann fail to cure the deficiencies of Hale and Fanning as described above. Of note, Schneier also fails to teach or suggest the above recited feature and is not cited as such.

Thus, since the cited references fail to teach or suggest, either alone or in combination, collecting an illegally produced digital music file, encrypting (claim 1) or inserting a watermark (claim 7) into the collected file and redistributing the encrypted or watermarked file as recited in independent claims 1 and 7, any combination of the cited references will likewise fail to render independent claims 1 and 7 obvious.

Claims 2-11 depend either directly or indirectly from a respective one of independent claims 1 and 7, and as such, include all the recitations of their respective independent claims. Dependent claims 2-11 are therefore patentably distinct from the cited references, individually or in combination, for at least the same reasons as given above for independent claims 1 and 7.

In view of the all of the reasons given above, Applicants respectfully submit that the rejection of claims 1-18 under 35 U.S.C. § 103(a) should be reversed.